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William Christopher Draper JR.

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EXAMINER

CARDENAS NAVIA, JAIME F

ART UNIT

PAPER NUMBER

3624

NOTIFICATION DATE

DELIVERY MODE

03/18/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

dcptopatent@hhlaw.com

Office Action Summary	Application No. 10/608,428	Applicant(s) DRAPER ET AL.	
	Examiner Jaime Cardenas-Navia	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01/22/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. This **NON-FINAL** office action is in response to communications received on January 22, 2009. Claims 1-20 have been cancelled. Claims 21-40 have been added. Claims 21-40 are currently pending.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 22, 2009 has been entered.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on January 22, 2009 has been considered by the Examiner.

Response to Amendment

4. **New grounds of rejection under 35 U.S.C. § 112, first paragraph**, have been necessitated by amendment and are presented below.

5. **New grounds of rejection under 35 U.S.C. § 101** have been necessitated by amendment and are presented below.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. **Claims 21-40 are rejected** under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 21, the specification lacks enabling disclosure for many of the steps performed by the electronic training delivery system. More specifically, for the step of planning course delivery, further detailed in dependent claims 22, 23 and 27, the specification provides little or no detail on how course delivery is planned. It merely contains vague language on potential functionality of the system, with no specifics on how the functionality is actually achieved. For example, when discussing prioritizing delivery of courses using the DSP (p. 13 and 14 of specification), the specification merely mentions that relevant criteria is established using all the relevant information from an enterprise. This is followed by a list of what Examiner assumes is relevant information, such as 'specific business needs, audience types..., equipment, and other factors'. There is absolutely no disclosure as to how this relevant information is collected, used to establish

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relevant criteria, or how the criteria are then used to prioritize course delivery. There is similarly vague language when describing all functional limitations of dependent claims 22, 23 and 27, particularly for creating cost forecasts, managing facilities and/or equipment used in courses, defining instructor certification criteria, determining whether course materials can be delivered to another locale, providing information to communicated with the relevant target audience, proactive and reactive scheduling of courses, managing over or under-utilization of resources, and creating non-conflicting course sessions. The limited disclosure found on p. 14 is not enabling.

Regarding 'capturing and storing user data' for the intended use of forecasting demand, and 'forecasting demand for each course using the captured user data', further elaborated on in claim 30, the specification is similarly bare for what the user data is, how it is collected and stored, and how it is utilized to forecast demand. p. 14 of the specification mentions 'an electronic tool that enables multi-dimensional views of the information, thereby enabling forecasters to understand and utilize information in a holistic manner for schedule optimization.' There is absolutely no enabling disclosure for this electronic tool, just a statement of its existence.

Similarly, regarding 'creating a schedule for each course based on the forecasted demand', there is no enabling disclosure. There is just a brief mention of a scheduling team using a scheduling tool, which may be regional and global, and a list of information that is used in the scheduling process (p. 14). There is no mention how the information is collected or actually used to create a schedule, just statements of what the hypothetical tool is capable of.

Regarding 'delivering courses', which is further elaborated on in dependent claims 24-26, and 28, there is no enabling disclosure. For example, there is no detail as to how a course is delivered to evaluate the effectiveness of its content and presentation methods, instructors are trained, course materials are obtained, course location is prepared, course instruction delivered, quality of instruction reviewed, etc. There are just broad statements that all these functionalities are accomplished by a sub-module (p. 15-17).

For at least the reasons stated above, the claimed invention lacks enabling disclosure. Claims 31-40 claim substantially similar subject matter as claims 21-30 and lack enabling disclosure for at least the same reasons. Examiner asks that Applicant specifically point out where detailed support for these limitations can be found.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. **Claims 31-40 are rejected** under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent (See *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978)) and recent Federal Circuit decisions (See *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (2008)), a method claim must have a specialized, limited meaning to qualify as a patent-eligible process claim. This is embodied in the "machine or transformation test", which states that a § 101 process must (1) be tied to a particular machine or apparatus or (2) transform a particular article to a different state or thing.

More specifically, the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Thus, a field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. Additionally, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. Thus, reciting a specific machine or a particular transformation in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

Independent claim 1 contains steps that are not necessarily tied to a particular machine or apparatus and are therefore directed to non-statutory subject matter. Examiner notes that for process claims implemented on a computer to be considered statutory, they must make clear which steps are executed on the computer and which steps are executed manually.

Examiner does not believe it has been made sufficiently clear that the steps are performed on a computer, rather than merely implemented with the aid of a computer. For purposes of examination, Examiner has assumed that necessary corrections have been made.

Response to Arguments

10. Examiner would like to thank Applicant for their comments regarding the newly presented claims in relation to the prior art. They have been thoroughly considered and taken into account in writing this office action. The new grounds of rejection presented below are necessitated by amendment.

Claim Rejections - 35 USC § 102

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11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent,

or

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. **Claims 21, 22, 24, 31, 32, and 34 are rejected** under 35 U.S.C. 102(a) and 102(e) as being anticipated by Bull (US 6,409,514 B1).

Regarding claim 21, Bull teaches an electronic training delivery system for training members of an organization (Abstract), comprising:

a processor (fig. 5); and

a computer-readable medium encoding instructions for (fig. 5):

planning course delivery (col. 3, lines 24-32, 36-38, 53-57),

capturing and storing user data in order to forecast demand (col. 3, lines 24-32, breaking class into sections, 36-38, 53-57),

forecasting demand for each course using the captured user data (col. 3, lines 24-32, breaking class into sections, 36-38, 53-57),

creating a schedule for each course based on the forecasted demand (col. 3, lines 24-32, 36-38, 53-57),

delivering courses (col. 4, lines 14-18. Electronically storing the worker's performance implies courses have been delivered), and

collecting data during course delivery and preparation of delivery (col. 4, lines 14-18, electronically storing worker's performance).

Regarding claim 22, Bull teaches an interface for receiving user instructions (col. 6) to perform at least one of:

monitoring data collected during course delivery (col. 4, lines 14-18),
updating the electronic training delivery system (col. 3, inputting new information),

generating performance reports (col. 4, lines 14-18, electronically notifying worker of performance),

archiving course content (col. 3, lines 51-61, inputting courses),
receiving requests for training (fig. 1),
creating training proposals (fig. 1),
creating cost forecasts,
managing facilities and/or equipment used in courses,
defining instructor certification criteria,
monitoring instructor quality,
determining whether course materials can be delivered to another locale, or
providing information to communicate with the relevant target audience (fig. 1-3).

Regarding claim 24, Bull teaches wherein delivering courses comprises at least one of:

delivering a course to evaluate the effectiveness of its content and/or presentation methods,

training instructors to deliver course content,

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ordering, reproducing, and/or delivering course materials,
preparing the course location for course delivery,
delivering course instruction (col. 4, implied),
collecting student rosters and/or assessments (fig. 1-3, col. 3, 4, worker's
performance, course sections), or

distributing student certificates (col. 4, certifications).

Regarding claims 31, 32, and 34, they are rejected using the same art and rationale used above for rejecting claims 21, 22, and 24. This is because claims 31, 32, and 34 claim a method for performing the functions of the system of claims 21, 22, and 24.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. **Claims 23, 25-29, 33, and 35-39 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Bull (US 6,409,514 B1).

Regarding claim 23, Bull teaches wherein planning course delivery comprises prioritizing delivery of courses to the organization (fig. 2, checking for core classes is prioritizing),
scheduling delivery of courses, either proactively or reactively (fig. 1-3), and

managing over-utilization or under-utilization of courses, including cancelling, rescheduling, and/or adding courses (fig. 4, lines 24-38, breaking large course into sections).

Bull does not explicitly teach:

receiving information from product developers and/or subject matter experts during course development.

Official notice is given that receiving information from product developers and/or subject matter experts during course development is old and well-known.

All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions. The claimed invention is merely a combination of old and well-known elements, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Thus, it would have been obvious to combine the teachings, motivated by the advantage in improved course development.

Regarding claim 25, Bull does not explicitly teach wherein delivering courses is followed by

storing student assessments,
suggesting facility and/or equipment improvements, and
reviewing the quality of instruction.

Official notice is given that storing student assessments, suggesting facility and/or equipment improvements, and reviewing the quality of instruction is old and well-known.

All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their

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respective functions. The claimed invention is merely a combination of old and well-known elements, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Thus, it would have been obvious to combine the teachings, motivated by the well-known advantages to improving processes through feedback.

Regarding claim 26, Bull does not explicitly teach means for delivering courses comprising one of:

virtual instructor led training, self-paced training delivered via computer, or some combination thereof.

Official notice is given that all these methods of delivering courses are old and well-known.

All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions. The claimed invention is merely a combination of old and well-known elements, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Thus, it would have been obvious to combine the teachings, motivated by the cost and flexibility advantages of multiple means of teaching.

Regarding claim 27, Bull teaches wherein scheduling of courses utilizes a tool which manages information that includes instructor names (col. 1, lines 33-46), instructor skills, course location (col. 1, lines 33-46), course delivery method, estimated expenses for the course, or materials and equipment used.

Bull does not explicitly teach wherein scheduling of courses utilizes a tool which assists in creating non-conflicting course sessions.

Official notice is given that a tool which assists in creating non-conflicting course sessions is old and well-known.

All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions. The claimed invention is merely a combination of old and well-known elements, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Thus, it would have been obvious to combine the teachings, motivated by the cost-savings from avoiding scheduling conflicts.

Regarding claim 28, Bull does not explicitly teach wherein training instructors to deliver course content comprises certification of knowledge of the subject matter of the course, certification of presentation skills, and certification of effective use of delivery mechanisms.

Official notice is given that these types of certifications are old and well-known.

All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions. The claimed invention is merely a combination of old and well-known elements, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Thus, it would have been obvious to combine the teachings, motivated by the advantage in improved training by having certified instructors.

Regarding claim 29, Bull does not explicitly teach wherein the delivery system is implemented by at least one of:

outsourcing training to an independent entity that is acting according to a service level agreement, or

one of the units of the organization which meets performance metrics, allocates costs of the training, and bills other units for the training.

Official notice is given that outsourcing training to an independent entity that is acting according to a service level agreement is old and well-known.

All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions. The claimed invention is merely a combination of old and well-known elements, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Thus, it would have been obvious to combine the teachings, motivated by the potential resource savings achieved by outsourcing certain business services to specialized service providers.

Regarding claims 33 and 35-39, they are rejected using the same art and rationale used above for rejecting claims 23 and 25-29. This is because claims 33 and 35-39 claim a method for performing the functions of the system of claims 23 and 25-29.

15. **Claims 30 and 40 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Bull (US 6,409,514 B1) as applied to claims 21 and 31 above, further in view of Simmons (WO 98/03953 A2) and Hollingsworth (US 6,157,808).

Regarding claim 30, Bull teaches wherein the user data stored in order to forecast demand is selected from the group of:

course content (col. 4, lines 24-32, particular course), student demand (col. 3, lines 26-30, fig. 1-3), instructors (col. 1, lines 33-46), facilities (col. 1, lines 33-46, location), and any combination thereof (col. 1, lines 33-46).

Bull does not explicitly teach wherein the user data stored in order to forecast demand is selected from the group of:

course media type, equipment use.

Simmons teaches wherein the user data stored in order to forecast demand is selected from the group of:

course media type (p. 7, lines 2-5, claim 4, and also see Figures 1a and 2).

Hollingsworth teaches wherein the user data stored in order to forecast demand is selected from the group of:

equipment use (col. 7, lines 65-67 and col. 8, lines 1-3. The venue of a computer room takes into consideration that certain equipment such as computers is sometimes necessary for training).

One set of data does not affect the collection of other sets of data, and so all the claimed elements, which were known in the prior art, could have been combined by one skilled in the art with no change in their respective functions. The claimed invention is merely a combination of old and well-known elements, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Thus, it would have been obvious to combine the teachings of Bull with the teachings of

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Simmons, and Hollingsworth, motivated by the advantage of collecting all necessary data to effectively plan training activities.

Regarding claim 40, it is rejected using the same art and rationale used above for rejecting claim 30. This is because claim 40 claims a method for performing the functions of the system of claim 30.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jaime Cardenas-Navia whose telephone number is (571)270-1525. The examiner can normally be reached on Mon-Fri, 10:30AM - 7:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bradley Bayat can be reached on (571) 272-6704. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

March 12, 2009

/J. C./
Examiner, Art Unit 3624

/Bradley B Bayat/
Supervisory Patent Examiner, Art Unit 3624